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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,284	02/13/2001	Mikio Hashimoto	203058US2RD	9450
22850	7590	02/24/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			SON, LINH L D	
1940 DUKE STREET				
ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,284

Applicant(s)

HASHIMOTO ET AL.

Examiner

Linh LD Son

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responding to the RCE received on 09/22/2005.
2. Claims 1-19 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-8, 10-15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliott, US Patent No. 6,468,160.

5. As per claim 1:

Elliott discloses "A program distribution device for distributing executable programs through a network to a client device having a tamper resistant processor which is provided with a unique secret key and a unique public key corresponding to the unique secret key in advance" in (Col 4 lines 55-65, Col 11 lines 20-25, Col 13 lines 50-60, Col 24 lines 25-42, Col 24 lines 61-67), "the program distribution device comprising: a first communication path setup unit configured to set up a first communication path between

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the program distribution device and the client device for communications other than transfer of the executable programs in (Col 26 lines 37-62); "a second communication path set up unit configured to set up a second communication path directly connecting the program distribution device and the tamper resistant processor for transfer of the executable programs, the first and second communication paths being set up as different channels on an identical transmission line or as different transmission lines" in (Col 27 lines 20-48); "an encryption processing unit configured to produce an encrypted program by encrypting an executable program to be distributed to the client device" and executed within the tamper resistant processor, by using the unique public key of the tamper resistant processor" in (Col 25 lines 15-40, Col 26 lines 18-37); and "a transmission unit configured to transmit the encrypted program to the tamper resistant processor through the second communication path so that the encrypted program is directly delivered to the tamper resistant processor and the encrypted program can be decrypted and executed only within the tamper resistant processor which is an only entity that has the unique secret key corresponding to the unique public key" in (Col 25 lines 14-24, Col 25 lines 29-63, and Col 29 lines 5-17). However, Elliott does not specifically teach the tamper resistant processor. Nevertheless, Elliott does teach a computer system including: a security processor 180 to authenticate the storage device, which stores the download encrypted game, and if authenticated then the downloaded encrypted games can be accessed to for decrypting for playing (Col 25 lines 35-63). Therefore, it is obvious at the time of the invention was made for one having ordinary skill in the art to realize that the game system 50 is the tamper resistant processor.

6. As per claims 2, 8, and 15:

Elliott discloses "The program distribution device of Claim 1, further comprising: a user authentication unit configured to carry out authentication of a user who is using the client device, by using a user ID of the user received from the client device through the first communication path" in (Col 26 lines 55-60).

7. As per claims 4 and 10:

Elliott discloses "The program distribution device of claim 1, wherein the encryption processing unit encrypts the executable program by using the unique public key received from the tamper resistant processor through the second communication path" in (Col 27 lines 20-35).

8. As per claims 5, 11, and 18:

Elliott discloses "The program distribution device of Claim 1, wherein the encryption processing unit encrypts the executable program by using a common key, and encrypts the common key by using the unique public key received from the tamper resistant processor through the second communication path; and the transmission unit transmits the encrypted program along with an encrypted common key to the tamper resistant processor through the second communication path" in (Col 25 lines 15-27, and Col 27 lines 50-60).

9. As per claims 6, 12, and 19:

Elliott discloses "The program distribution device of Claim 1, wherein communications through the second communication path are cipher communications" in (Col 27 lines 50-55).

10. As per claims 7, and 13-14:

Elliott discloses "A client device for receiving programs distributed from a program distribution device through a network, the client device comprising: a tamper resistant processor which is provided with a unique secret key and a unique public key corresponding to the unique secret key in advance" in (Col 4 lines 55-65, Col 11 lines 20-25, Col 13 lines 50-60, Col 24 lines 25-42, Col 24 lines 61-67), "a first communication path set up unit configured to set up a first communication path between the program distribution device and the client device for communications other than transfer of the executable programs" in (Col 26 lines 37-62); "a second communication path set up unit configured to set up a second communication path directly connecting the program distribution device and the tamper resistant processor for transfer of the executable programs; the first and second communication paths being set up as different transmission lines" in (Col 27 lines 20-48); and a program receiving unit configured to receive an encrypted program obtained by encrypting an executable program to be distributed to the client device and executed within the tamper resistant

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processor, by using the unique public key of the tamper resistant processor, from the program distribution device through the second communication path, so that the encrypted program is directly delivered to the tamper resistant processor and the encrypted program can be decrypted and executed only within the tamper resistant processor which is an only entity that has the unique secret key corresponding to the unique public key" in (Col 25 lines 14-24, Col 25 lines 29-63, and Col 29 lines 5-17).

However, Elliott does not specifically teach of encrypting the program using the unique public key, and decrypting the encrypted program using the unique secret key.

Nevertheless, Elliott does disclose of encrypting the program using the private encryption key of the tamper resistant process and decrypting the encrypted program using a decryption key stored in the storage" in (Col 25 lines 14-24). The encryption key is sent to the server encrypted using the private key of the game system 50. The server receives the private encrypted encryption key and decrypts it using a prior exchanged public key of the game system 50. Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify the invention to utilize only the public key of the game system 50 to encrypted the program instead of sending another encryption key to server to encrypt the program.

Further, Elliott does not specifically teach the tamper resistant processor. Nevertheless, Elliott does teach a computer system including: a security processor 180 to authenticate the storage device, which stores the download encrypted game, and if authenticated then the downloaded encrypted games can be accessed to for decrypting for playing (Col 25 lines 35-63). Therefore, it is obvious at the time of the invention was made for

one having ordinary skill in the art to realize that the game system 50 is the tamper resistant processor.

11. As per claim 17:

Elliott does not specifically teach "the producing step encrypts the executable program by using the unique public key received from the tamper resistant processor through the second communication path". Nevertheless, Elliott does disclose of encrypting the program using the private encryption key of the tamper resistant process and decrypting the encrypted program using a decryption key stored in the storage" in (Col 25 lines 14-24). The encryption key is sent to the server encrypted using the private key of the game system 50. The server receives the private encrypted encryption key and decrypts it using a prior exchanged public key of the game system 50. Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify the invention to utilize only the public key of the game system 50 to encrypted the program instead of sending another encryption key to server to encrypt the program.

12. Claims 3, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliott, in view of Chan (Cited in PTO-892 dated 04/22/05).

13. As per claims 3, 9, and 16:

Elliott does not disclose "The program distribution device further comprising: a processor authentication unit configured to carry out authentication of the tamper resistant processor, by verifying a certificate certifying that the tamper resistant processor surely has the unique secret key and the unique public key, which is received from the client device through the second communication path". Nevertheless, Chan does disclose "The program distribution device further comprising: a processor authentication unit configured to carry out authentication of the tamper resistant processor, by verifying a certificate certifying that the tamper resistant processor surely has the unique secret key and the unique public key, which is received from the client device through the second communication path" in (Col 10 lines 4-35). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to incorporate the teaching of Chan with Elliott to authenticate the game system 50 prior allow it to download any program.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856.

The examiner can normally be reached on 9-6 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son
Examiner
Art Unit 2135

LDS
primary Examiner
Art Unit 2135